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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,355	09/07/2005	Xiaofeng Wu	1406/259	1081
25297 7590 11/18/2008 JENKINS, WILSON, TAYLOR & HUNT, P. A. Suite 1200 UNIVERSITY TOWER 3100 TOWER BLVD., DURHAM, NC 27707				
EXAMINER TORRES, JOSEPH D				
ART UNIT		PAPER NUMBER		
2112				
MAIL DATE		DELIVERY MODE		
11/18/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/532,355

Applicant(s)

WU, XIAOFENG

Examiner

Joseph D. Torres

Art Unit

2112

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CD/CD)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Drawings

The drawings were received on 10/10/2008. These drawings are approved.

Specification

The abstract was received on 10/10/2008. The abstract is approved.

Response to Arguments

Applicant's arguments filed 10/10/2008 have been fully considered but they are not persuasive.

The Applicant contends, "Applicant respectfully submits that the amendments to the claims 2-7 address the Examiner's concerns. Accordingly, in view of the above remarks and amendments, applicant respectfully submits that the objections to the claim should now be withdrawn."

The Examiner disagrees and asserts that claims 2-5 do not recite any limitation that can be construed as a structural element and/or structural interconnections further limiting a Prior Art EGRS receiving apparatus comprising an IR memory with first and second memory areas. The only structural elements recited in claims 1-5 are a Prior Art EGRS receiving apparatus comprising an IR memory with first and second memory areas. Configuring the EGRS receiving apparatus comprising an IR memory with first and

second memory areas of claims 1-5 to store different sets of data based on data resolution does not suggest any structural changes to the EGRS receiving apparatus comprising an IR memory with first and second memory areas of claims 1-5. Even the Applicant acknowledges this by teaching IR memory with first and second memory areas of Figure 9 in the Applicant's specification is structurally identical to the IR memory with first and second memory areas of Figures 6 in the Applicant's specification, the only difference being intended use of the identical IR memories with first and second memory areas of Figures 6 and 9. That is the identical IR memories with first and second memory areas of Figures 6 and 9 are intended for use in storing different types of data.

The Applicant contends, "In particular, while applicant respectfully regards these 35 U.S.C. § 112, second paragraph, rejections as being misapplied, the claims have been amended to impart structural elements to a memory within a receiver".

The Examiner disagrees and asserts that claims 2-5 do not recite any limitation that can be construed as a structural element and/or structural interconnections further limiting EGRS receiving apparatus comprising an IR memory with first and second memory areas. The only structural elements recited in claims 1-5 are an EGRS receiving apparatus comprising an IR memory with first and second memory areas. Configuring the EGRS receiving apparatus comprising an IR memory with first and second memory areas of claims 1-5 to store different sets of data based on data resolution does not suggest any structural changes to the EGRS receiving apparatus comprising an IR

memory with first and second memory areas of claims 1-5. Even the Applicant acknowledges this by teaching IR memory with first and second memory areas of Figure 9 in the Applicant's specification is structurally identical to the IR memory with first and second memory areas of Figures 6 in the Applicant's specification, the only difference being intended use of the identical IR memories with first and second memory areas of Figures 6 and 9. That is the identical IR memories with first and second memory areas of Figures 6 and 9 are intended for use in storing different types of data.

As per newly added functional limitations to claim 1 concerning intended use of the identical IR memories with first and second memory areas of Figures 6 and 9 of the Applicant's specification for storing different sets of data then what identical IR memories with first and second memory areas of Figures 6 and 9 were used for in the past: such use fails to suggest any limitation that can be construed as a structural element and/or structural interconnections further limiting EGRS receiving apparatus comprising an IR memory with first and second memory areas.

The Applicant contends, "The Art does not disclose each and every feature as recited in claim 1. For example, the Art does not disclose a first memory area configured to buffer-store a specific number of data blocks with a predetermined first data resolution and a second memory area configured to store the erroneously decoded data blocks with a second data resolution, which is lower than the first data resolution".

Such intended use as recited by the Applicant does not suggest any limitation that can be construed as a structural element and/or structural interconnections further limiting EGRS receiving apparatus comprising an IR memory with first and second memory areas.

The Examiner disagrees and asserts while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, not what a device does (Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)).

That is, the boundaries of the subject matter for an apparatus are only made clear in terms of structure rather than function and unless the functional and/or descriptive material are explicitly written in a fashion that imparts some structural limitation on the apparatus, a functional limitation cannot be regarded as distinguishing over the Prior Art.

Thus, if a prior art structure is capable of performing the intended use as recited in the preamble, or elsewhere in a claim, then it meets the claim.

The Applicant contends, "Further, the Art does not disclose that the second data resolution with which the erroneously decoded data blocks are stored in the second memory area of the IR memory is configured to be set adaptively between different resolution levels dependent on a measured burst data transmission signal quality. The art does not disclose any second data resolution".

Such intended use as recited by the Applicant does not suggest any limitation that can be construed as a structural element and/or structural interconnections further limiting EGRS receiving apparatus comprising an IR memory with first and second memory areas.

The Examiner disagrees and asserts while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, not what a device does (*Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)).

That is, **the boundaries of the subject matter** for an apparatus are only made clear in terms of structure rather than function and unless the functional and/or descriptive material are explicitly written in a fashion that imparts some structural limitation on the apparatus, a functional limitation cannot be regarded as distinguishing over the Prior Art.

Thus, if a prior art structure is capable of performing the intended use as recited in the preamble, or elsewhere in a claim, then it meets the claim.

Claim Objections

Claims 2-5 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. While features of

an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, not what a device does (Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)). Claims 2-5, 8 and 9 fail to recite any limitation in the form of a structural element and/or structural interconnections of elements further limiting the IR memory apparatus of claim 1. Claims 2-5, 8 and 9 instead recite functional steps/actions and/or data characteristics/attributes of abstract data structures.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites "An EGPRS receiver of a mobile station". Nowhere does the Applicant teach an EGPRS receiver incorporating the IR memory of Figure 9 in the Applicant's specification. For the purposes of advancing prosecution the Examiner assumes the following was intended: --A Prior Art EGPRS receiver of a mobile station--.

Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, because the best mode contemplated by the inventor has not been disclosed. Evidence of concealment of the best mode is based upon the fact that nowhere does the Applicant teach an EGPRS receiver incorporating the IR memory of Figure 9 in the Applicant's specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. Claim 1 recites, the intended functional use of "configured to buffer-store a specific number of data blocks with a predetermined first data resolution", "configured to buffer-store erroneously decoded data blocks" and "configured to store the erroneously decoded data blocks with a second data resolution, which is lower than the first data resolution, and d) wherein the second data resolution with which the erroneously decoded data blocks are stored in the second memory area of the IR memory is configured to be set adaptively between different resolution levels dependent on a measured burst data transmission signal quality".

The Examiner asserts while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, not what a device does (Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)).

That is, **the boundaries of the subject matter** for an apparatus are only made clear in terms of structure rather than function and unless the functional and/or descriptive material are explicitly written in a fashion that imparts some structural limitation on the apparatus, a functional limitation cannot be regarded as distinguishing over the Prior Art.

As per newly added functional limitations to claim 1 concerning intended use of the identical IR memories with first and second memory areas of Figures 6 and 9 of the Applicant's specification for storing different sets of data then what identical IR memories with first and second memory areas of Figures 6 and 9 were used for in the past; such use fails to suggest any limitation that can be construed as a structural element and/or structural interconnections further limiting EGRS receiving apparatus comprising an IR memory with first and second memory areas.

Furthermore; in *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976), it is clearly pointed out that functional limitations are only excluded from considerations under 35 U.S.C. 112, second paragraph, when a functional limitation imparts some structural limitation on an apparatus (i.e. sleeves "adapted to be fitted" Note: a sleeve "adapted to

be fitted" requires a specific physical alteration to a sleeve since any sleeve that is not "adapted to be fitted" is necessarily structurally different from what is being claimed). Since the functional matter recited in the Applicant's claims can be implemented in software or can be implemented without requiring structural changes to existing circuitry that does not implement such a function such as programmable logic, the functional matter in the Applicant's claims does not conform to the requirement that a limitation for an apparatus distinguish from the Prior Art in terms of structure rather than function. The functional matter in the Applicant's claims instead raises questions as to the structural connection of the functional matter to structural elements in the claim to the degree that **it is not even clear, if the functional matter as recited imparts any structural connection to any structural element in the claim.** As such, the functional matter as recited in claims 1-9, is indefinite and fails to comply with 35 U.S.C. 112, second paragraph.

Claims 2-5 fail to recite any limitation in the form of a structural element and/or structural interconnections of elements further limiting the IR memory apparatus of claim 1. Claims 2-5, 8 and 9 instead recite functional steps/actions and/or data characteristics/attributes of abstract data structures. The Examiner asserts while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a

device is, not what a device does (Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)).

That is, **the boundaries of the subject matter** for an apparatus are only made clear in terms of structure rather than function and unless the functional and/or descriptive material are explicitly written in a fashion that imparts some structural limitation on the apparatus, a functional limitation cannot be regarded as distinguishing over the Prior Art.

The Examiner asserts that claims 2-5 do not recite any limitation that can be construed as a structural element and/or structural interconnections further limiting EGRS receiving apparatus comprising an IR memory with first and second memory areas. The only structural elements recited in claims 1-5 are an EGRS receiving apparatus comprising an IR memory with first and second memory areas. Configuring the EGRS receiving apparatus comprising an IR memory with first and second memory areas of claims 1-5 to store different sets of data based on data resolution does not suggest any structural changes to the EGRS receiving apparatus comprising an IR memory with first and second memory areas of claims 1-5. Even the Applicant acknowledges this by teaching IR memory with first and second memory areas of Figure 9 in the Applicant's specification is structurally identical to the IR memory with first and second memory areas of Figures 6 in the Applicant's specification, the only difference being intended use of the identical IR memories with first and second memory areas of Figures 6 and 9. That is the identical IR memories with first and second

memory areas of Figures 6 and 9 are intended for use in storing different types of data.

Furthermore; in *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976), it is clearly pointed out that functional limitations are only excluded from considerations under 35 U.S.C. 112, second paragraph, when a functional limitation imparts some structural limitation on an apparatus (i.e. sleeves "adapted to be fitted" Note: a sleeve "adapted to be fitted" requires a specific physical alteration to a sleeve since any sleeve that is not "adapted to be fitted" is necessarily structurally different from what is being claimed).

Since the functional matter recited in the Applicant's claims can be implemented in software or can be implemented without requiring structural changes to existing circuitry that does not implement such a function such as programmable logic, the functional matter in the Applicant's claims does not conform to the requirement that a limitation for an apparatus distinguish from the Prior Art in terms of structure rather than function.

The functional matter in the Applicant's claims instead raises questions as to the structural connection of the functional matter to structural elements in the claim to the degree that it is not even clear, if the functional matter as recited imparts any structural connection to any structural element in the claim. As such, the functional matter as recited in claims 1-5, is indefinite and fails to comply with 35 U.S.C. 112, second paragraph.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by the Applicant's Admitted Prior Art.

35 U.S.C. 102(b) rejection of claims 1-5.

The only structural elements recited in claims 1-5 are a Prior Art EGRS receiving apparatus comprising an IR memory with first and second memory areas.

FIG. 6 in the Applicant's Admitted Prior Art "schematically shows an IR memory according to the prior art. The IR memory according to the prior art comprises a first memory area SB_A and a second memory area SB_B . The first memory area SB_A serves for buffer-storing a specific number of RLC data blocks with a predetermined data resolution R"... "The second memory area SB_B within the IR memory according to the prior art serves for storing the erroneously decoded RLC data blocks".

As per functional limitations describing intended use in claim 1: "configured to buffer-store a specific number of data blocks with a predetermined first data resolution", "configured to buffer-store erroneously decoded data blocks" and "configured to store the erroneously decoded data blocks with a second data resolution, which is lower than the first data resolution, and d) wherein the second data resolution with which the

erroneously decoded data blocks are stored in the second memory area of the IR memory is configured to be set adaptively between different resolution levels dependent on a measured burst data transmission signal quality" (**such intended use as recited by the Applicant does not suggest any limitation that can be construed as a structural element and/or structural interconnections further limiting EGRS receiving apparatus comprising an IR memory with first and second memory areas**); while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, not what a device does (Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)).

That is, **the boundaries of the subject matter** for an apparatus are only made clear in terms of structure rather than function and unless the functional and/or descriptive material are explicitly written in a fashion that imparts some structural limitation on the apparatus, a functional limitation cannot be regarded as distinguishing over the Prior Art. **Thus, if a prior art structure is capable of performing the intended use as recited in the preamble, or elsewhere in a claim, then it meets the claim.**

As per functional limitations describing intended use in claims 2-5, 8 and 9; while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, because apparatus claims cover what a device is, not what a

device does (Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)).

That is, the boundaries of the subject matter for an apparatus are only made clear in terms of structure rather than function and unless the functional and/or descriptive material are explicitly written in a fashion that imparts some structural limitation on the apparatus, a functional limitation cannot be regarded as distinguishing over the Prior Art. Thus, if a prior art structure is capable of performing the intended use as recited in the preamble, or elsewhere in a claim, then it meets the claim.

35 U.S.C. 102(b) rejection of claims 6 and 7.

Figures 5 and 6 in the Applicant's Admitted Prior Art.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D. Torres whose telephone number is (571) 272-3829. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques can be reached on (571) 272-6962. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joseph D. Torres
Primary Examiner
Art Unit 2112

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